EXHIBIT I

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

January 8, 2008

Patent No.: 6,079,666
Applicant : Alton B. Hornback
Issued : June 27, 2000
For : **REAL TIME BORESIGHT ERROR SLOPE SENSOR**

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent received in the August 6, 2007.

The errors requested to be corrected in the claims will not be entered. The broadening of claims may affect patentability of claims.

In view of the foregoing, your request in this matter is hereby denied.

A certificate of correction will be issued to correct the remaining errors in your request.

Further correspondence concerning this matter should be filed and directed to Decisions and Certificates of Correction Branch.

For Mary F. Diggs
Decisions & Certificates
of Correction Branch
(703) 308-9390 ext. 125

ALTON B. HORNBACK
5650 BLOCH STREET
SAN DIEGO CA 92122

AJ

EXHIBIT J

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MAILED EJB
APR 03 2008

In re Patent No. 6,079,666 :
Issue Date : June 27, 2000 :
Application No. 06/859,033 : ON PETITION
Filed: April 25, 1986 :
Attorney Docket No. 6021270 :
Patentee Alton B. Hornback

This is a decision on the petitions filed August 6, 2007 and August 13, 2007 requesting the correction of errors in issued patent 6,079,666, issued June 27, 2000. The request is being considered under 37 CFR 1.322(b), as a request for Certificate of Corrections, due to an alleged Office mistake.

The petition is **DENIED**.

BACKGROUND

The patent issued on June 27, 2000. On August 21, 2000, petitioner filed a letter with the Office requesting that a new patent be issued pursuant to 37 CFR § 1.322(b). Following dismissals from the U.S. Court of Appeals for the Federal Circuit and the U.S. District Court, Southern District of California, dated September 28, 2001 and May 15, 2007 respectively; petitioner's next response was to file another letter with the Office requesting correction of errors in his specification and claims, and that the patent be reissued under 35 U.S.C. § 1.131 and 35 U.S.C. § 251.

On July 25, 2007 the Office of Petitions sent correspondence to petitioner regarding a proposed Certificate of Correction (correcting errors in the specification) and information on correcting patents. On August 6, 2007 petitioner responded requesting a reissue under 35 U.S.C § 251. The petitioner's response acknowledged the proposed Certificate of Correction to the specification, in the July 25, 2007 letter from the Office. He also presented his own Certificate of Corrections Form PTO/SB/44. The petitioner's Certificate requested corrections to errors in the specification as well as alleged errors present in the claims.

On August 13, 2007, petitioner submitted a supplemental letter regarding the requested reissue, indicating that all errors requiring correction were based on an Office mistake. The supplemental response also contained a conditional request to file a reissue application. On November 6, 2007 the Office advised petitioner that the Office would include petitioner's requested changes to the specification in the Certificate of Correction, which would be forwarded by Memorandum to the Certificate of Corrections Branch. The letter from the Office also notified petitioner that the requested Certificate of Correction to the claims would be forwarded to the Certificate of Correction Branch for its consideration. In that letter, the Office returned petitioner's reissue fee check of $395.00 because the submitted request was conditional and did not comply with the many requirements for a reissue application set forth in 35 U.S.C. § 251, and 37 CFR §§ 1.171 through 1.178. A one-month time limit was set, and petitioner was informed that if no reply is received within the one-month time limit, the matter would be decided on the record.

On January 8, 2008 Certification of Corrections Branch issued a notice indicating that the changes to the claims would not be entered and that the Certificate of Correction would correct the errors in the specification. The Office has received no further communication. Having received no additional response from the petitioner, this matter is now being decided on the record.

Statutes and Regulations

35 U.S.C. § 131 Examination of application.

> The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. § 154 Contents and term of patent; provisional rights.

> (a)...
> (4) SPECIFICATION AND DRAWING.—A copy of the specification and drawing shall be annexed to the patent and be a part of such patent.

35 U.S.C. § 254 Certificate of correction of Patent and Trademark Office mistake.

> Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

37 CFR § 1.322 Certificate of correction of Office mistake.

> (a)(1) The Director may issue a certificate of correction pursuant to 35 U.S.C. § 254 to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:
>
> (i) At the request of the patentee or the patentee' s assignee;
>
> ...
>
> (4) The Office will not issue a certificate of correction under this section without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard.
>
> (b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

OPINION

As 35 U.S.C § 254 and 37 CFR § 1.322 set forth, the Director may issue a Certificate of Correction whenever a mistake in a patent, incurred through the fault of the Office, is clearly disclosed by the records of the Office. The patent, together with such Certificate of Correction, shall have the same effect and operation of law as if the same had been originally issued in such correct form. If the nature of the mistake on the part of the Office is such that a Certificate of Correction is deemed inappropriate in form, the Director may issue a corrected patent. The Office has, on January 29, 2008, issued the Certificate of Correction that corrected the errors in the specification.

Petitioner requests that a new patent be issued pursuant to 35 U.S.C. § 131. Alternatively, petitioner requests that a corrected patent pursuant to 37 CFR § 1.322(b) be issued. Specifically, petitioner alleges that the Director under 35 U.S.C. § 131 must issue a patent which conforms to the patent application; that since U.S. Patent No. 6,079,666 does not conform to allowed patent Application No. 06/859,033, by law the patent must be reissued. Petitioner alleges that the printed claims were not the allowed claims because the Supplemental Amendment filed May 11, 1987, cancelled original claims 1 and 2 and added claims 3-4(amended) and claims 5-6(new). Finally, petitioner submits that the errors in U.S. Patent 6,079,666 were, without exception, the fault of the USPTO, that the nature and extent of the errors are such that a Certificate of Corrections is clearly inappropriate in form, that the invention described in the issued patent, is not the same invention as that disclosed in the allowed patent application, and therefore, the USPTO should either issue a new patent or a corrected patent.

First, 35 U.S.C. § 131 does not authorize the United States Patent and Trademark Office to correct a patent, but applies to examination of an application. The status of an application is one of three conditions: (1) pending, (2) patented, or (3) abandoned. See In re Morganroth, 6 USPQ2d 1802, 1803 (Comm'r Pats. 1988). In addition under 35 USC § 120, proceedings in an application are concluded in three ways: (1) the application may issue as a patent, (2) the application may become abandoned, and (3) proceedings in the application may be terminated. As the above identified application is no longer a pending application, but since June 27, 2000, is instead an issued patent, there is no longer a pending application which may be subjected to the requested further examination within the meaning of 35 U.S.C. § 131, as this statute expressly requires, examination be performed on an application. Indeed as explained in MPEP 1305:

> Once the patent has been granted, the United States Patent and Trademark Office can take no action concerning it, except as provided by 35 U.S.C. § 135, 35 U.S.C. § 251 through 256, 35 U.S.C. §§ 302 through 307, and 35 U.S.C. §§ 311 through 316.

This is further reinforced by consideration of a standard principle of statutory construction: the mention of one thing implies exclusion of another thing. Absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n of R.R. Passengers, 414 U.S. 453, 458(1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided a specific scheme for the reexamination of a patent (i.e., the specific situation under which the Patent and Trademark Office may reexamine the claims of an issued patent is by way of a proceedings or via reissue and not by way of an application"), or alternatively, in 35 U.S.C. 251 by reissue for remedying an error in the as-issued specification, drawings, or claims, the creation of other schemes for further examining the claims in an issued patent would be inconsistent with the patent statute. Thus the Commissioner's authority to further examine or reexamine the claims in the above identified issued patent is limited to that specified in the statutory scheme set forth in 35 U.S.C. 251 through 256, 302 through 307, and 311 through 316. That is, it would be an inappropriate exercise of 35 U.S.C. 131 to in essence, fashion yet another means of examining the claims contained in an issued patent.

Second, upon a review of the record it is the position of the Office that the appropriate method of correction is via the Certificate of Correction issued January 29, 2008, making changes to the specification of the issued patent is appropriate, and issuance of a new or corrected patent is not necessary. The nature of the mistakes in the specification on the part of the Office with respect to the above-identified patent is such that a Certificate of Correction is deemed more appropriate. Specifically, the mistakes petitioner requested be corrected (Attachment 1 of his August 6, 2007 response), are clerical or typographical in nature and are precisely the type of errors intended for a Certificate of Correction under 37 CFR § 1.322(b). The errors found in Attachment 1 are not gross or so numerous that a Certificate of Correction is deemed inappropriate in form.

The United States Patent and Trademark has a long history of issuing Certificates of Corrections to correct errors in patents arising from its processing and patent printing operations that actually predates the statutory authorization provided by 35 U.S.C § 254 and its 1925 predecessor statute. See McCrady, Patent Office Practice, 4th Ed. (2959) at 439. Correction of mistakes attributable to The United States Patent and Trademark Office in printed patents, via Certificate of Correction, have run the gamut from the trivial, such as punctuation errors, to omitted drawings and examined but omitted claims. Here during prosecution, petitioner filed a first response to an Office action on May 4, 1987, with an amendment that cancelled claims 1 and 2 and submitted new claims 3-6. On May 11, 1987 the Office received a Supplemental Response also requesting that claims 1 and 2 be cancelled and attempting to add claims 3-6.

At the time of the filing of the Supplemental Response, 37 CFR § 1.121 (1987) "Manner of Making Amendments," stated:

> (b) Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words being deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.

Emphasis added. At the time of the filing of the Supplemental Response, 37 CFR § 1.126 (1987) "Numbering of claims," stated:

> The original numbering of the claims must be preserved throughout prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 CFR § 1.121(b), they must be renumbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

Emphasis added. At the time of the filing of the amendments petitioner was required to follow either 37 CFR § 1.121 (1987) (requiring underlining added words and brackets around words being deleted) or 37 CFR § 1.126 (1987) (when adding claim they must be consecutively numbered, following the highest numbered claims previously presented).

Petitioner did not follow either rule. Therefore the effective result of the petitioner filing the Supplemental Response, using the exact same claim numbering (3-6), was improper. Petitioner should have numbered the substitute claims as claims 7-10. At allowance, the examiner mailed the Notice of Allowance indicating that claims 3-6 would be allowed. Claims 3-6, filed May 1, 1987 properly allowed. However, claims 3-6 mailed May 6, 1987 were, from a review of the record, never examined, but considered "duplicate" claims since they were not presented in the manner required by 37 CFR §§ 1.121 or 1.126.

When petitioner received the printed patent, he could have followed the rules of practice before the Office permitting correction of any claims by the filing of a reissue application within two years. 35 U.S.C. § 251, and 37 CFR §§ 1.171 through 1.178; MPEP § 1400. Petitioner never filed a reissue application within two years from the date of the issuance of the patent. Petitioner's failure to heed the clear MPEP guidance and the rules of practice before the Office will not be permitted to shift in equity his lack of diligence onto the United States Patent and Trademark Office. See Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985). Rather, it is incumbent upon petitioner to prosecute his invention with continuing diligence and an awareness of the statute. BEC Pressure Controls Corporation v. Dwyer Instruments, Inc., 380 F. Supp. 1397, 182 USPQ 190, 192 (D. C. N. Ind. 1974).

Claims 7-10 (3-6 in the Supplemental Response filed May 11, 1987) may change the scope of the invention by broadening the claims. Where a proposed correction involves a change in claim scope, the reissue statute is controlling, not the provisions of laws governing Certificate of Corrections. See Eagle Iron Works v. McLanahan Corporation, 429 F.2d 1375, 1383, 166 USPQ 225, 231 (3d Cir. 1970).

Petitioner essentially seeks to obtain through a Certificate of Correction a claim of a particular scope, which simply has never been evaluated on its merits by the Office. The United States Patent and Trademark Office simply does not have the authority to issue patents without first examining the claim. Blacklight Power, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002).As made clear by the application file, only claims 3-6 were examined and found allowable. If the petitioner's request were granted, the Office would be issuing a claim that may be broader than the ones allowed, claims that it never actually considered, much less determined to be patentable, which is simply an illogical result. That type of error is not amenable to corrections through 35 U.S.C 254; rather, reissue is the appropriate path to resolve this error.

DECISION

As noted, the Certificate of Correction was issued to correct errors in the patent specification. For the reasons given above, however, the decision of the Certificate of Corrections Branch mailed January 8, 2008 was proper in refusing the requested correction to the claims. Thus, the original petition is granted as to the requested Certificate of Correction to correct errors in the specification, but it is **DENIED** as to the issuance of a new patent, and as to a modification thereof or issuance of a new Certificate of Correction to correct alleged errors in the claims. While the requested claim correction will not be forthcoming under 35 U.S.C. §§ 254 or 255, petitioner may yet pursue relief under 35 U.S.C. § 251. The provisions of 35 U.S.C. § 251 permit the reissue of a patent to correct an error in the patent made without any deceptive intention. In accordance with 35 U.S.C. § 251, the error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of the patentee claiming more or less than he had a right to claim in the patent." There must be at least one error in the patent to provide grounds for reissue of the patent. If there is no error in the patent, the patent will not be reissued. No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent. Id.

Employ Services of Attorney or Agent

An examination of this file reveals that patentee is unfamiliar with patent prosecution procedure. Lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Patentee is advised to secure the services of a registered patent attorney or agent to handle the above Patent matters, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site http://www.uspto.gov in the Site Index under "Agents and Attorney Roster, Patent." Applicants may also obtain a list of registered patent attorneys and agents located in their general area by writing to Mail Stop OED, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450.

As the filing of a reissue application is even more complicated and complex than the prosecution of a non-provisional application, the Office reiterates its recommendation to employ the services of a practitioner.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6788 or 703-308-9390.

Robert P. Olszewski
Director, Technology Center 3700, OIPE, Publications and PCT Operations

4/1/2008

EXHIBIT K

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 6,079,666 Page 1 of 2
APPLICATION NO. : 06/859033
DATED : June 27, 2000
INVENTOR(S) : Alton B. Hornback

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In the specification, column 2, line 2, "statistic" should read -- statistics --;

Column 3, line 7, "(e)" should read -- (d) --;

Column 3, line 9, "(f)" should read -- (e) --;

Column 4, line 12, cancel the text, "Re";

Column 4, line 14, " $\left[\frac{\Delta}{\Sigma}\right]$. " should read -- Re $\left[\frac{\Delta}{\Sigma}\right]$. --;

Column 4, line 30, cancel the text, "Re";

Column 4, line 32, " $\left[\frac{\Delta}{\Sigma}\right]$ " should read -- Re $\left[\frac{\Delta}{\Sigma}\right]$ --;

Column 4, line 55, "6(LOS)" should read -- δ(LOS) --;

Column 5, lines 12, 49, and 63, for each occurrence, "$\delta(LOS\gamma\Delta\theta)$" should read -- $\delta(LOS\pm\Delta\theta)$ --;

Column 5, line 22, after "V_m", insert -- = -- and "$V_{DR}(LOS\Delta\theta)$" should read -- $V_{DR}(LOS-\Delta\theta)$ --;

Column 5, line 64, "$V_D(LOS\gamma\Delta\theta)$" should read -- $V_D(LOS\pm\Delta\theta)$ --;

Column 5, line 68, after "V_{AGC}" insert -- = -- and "$V_{DR}(LOS+\Delta\theta)$" should read -- $V_{DR}(LOS\pm\Delta\theta)$ --;

Column 6, line 30, " $\dot{\theta}$ " should read -- $\dot{\beta}$ --;

Column 6, line 40, "T" should read -- τ --; and

Column 6, line 54, cancel the text, "RE";

Column 6, line 57, " $\left[\frac{\Delta}{\Sigma}\right]$ " should read -- Re $\left[\frac{\Delta}{\Sigma}\right]$ Ratio detector output --; and

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 6,079,666 Page 2 of 2
APPLICATION NO. : 06/859033
DATED : June 27, 2000
INVENTOR(S) : Alton B. Hornback

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 6, line 60, cancel the text, "Ratio detector output".

Signed and Sealed this

Twenty-ninth Day of January, 2008

Jon W. Dudas

JON W. DUDAS
Director of the United States Patent and Trademark Office